

Application No. 10/817,621

b. Remarks

Claims 1, 2, 5, 6, 13-19, 23 and 24 stand rejected. Claims 4-24, as amended, are pending in the application. Claims 4, 7-12, and 20-22 have been withdrawn. Claim 3 was cancelled in the last Response/Amendment, which was dated August 4, 2005. Claims 1, 2, 5 and 6 have been cancelled herein.

I. Allowable Subject Matter

The nonfinal Office action dated May 4, 2005 acknowledged that *Claims 16 and 19 are directed to allowable subject matter* (see pages 6-7). The Examiner states at the top of page 7 in that Office action that "Claims 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. This was done in the August 4, 2005 Amendment/Response (see pages 5-7 and 11) to the May 4 Office action. In that August 4 Amendment/Response, amended Claims 16 and 19 were rewritten in proper independent form and the limitations of the base claim (Claim 13 for both) and the intervening claim (Claim 15, for Claim 16) were included. (There was no intervening claim for Claim 19.) In the same Amendment/Response, Claims 17 and 18 were amended to depend on independent Claim 16, which was believed to be in condition for allowance. No new matter was introduced by this August 4, 2005 Amendment.

The most recent (October 21) Office action did not say, per MPEP 706.04, that "The indicated allowability of claim [1] is withdrawn in view of the newly discovered reference(s) to [2]." Since it might have been an inadvertent oversight that Claims 16 and 19 were not allowed in the recent, October 21 nonfinal Office action even though the two claims were designated allowable subject matter (see bottom of page 6) in the May 4

Office action, Applicants request allowance of the previously allowable Claims 16 and 19, if possible.

2. Rejection under §102(b)

Claims 1, 2, 6, 13, 19, and 24 stand rejected under 35 USC §102(b) as being anticipated by Scheidecker.

Claims 1, 5, 13-15, 19, and 24 stand rejected under 35 USC §102(b) as being anticipated by Hayward.

Lastly, Claims 16, 17, and 23 stand rejected under 35 USC §102(b) as being anticipated by Roi.

Applicants respectfully disagree, but have voluntarily amended the claims in the interest of gaining an auspicious allowance. Claims 1, 2, 5 and 6 have been cancelled.

a. Scheidecker

According to page 3 of the October 21 Office action regarding Claims 13 and 19, among other things, Applicants respectfully disagree that item 15 in Scheidecker indicates a brace per Applicants' Claims 13(b) & 19(b). Scheidecker's potato masher /whipper reportedly may be used as a whipper separately or in conjunction with the masher means (col. 1, lines 40-43). In Scheidecker, item 15 indicates rotating wings 15 rather than a stationary brace. Applicants also submit that item 11 does not designate a mount portion connected to a brace per Applicants' Claims 13(b) & 19(c). The wings 15 extend radially from a shaft 14 mounted on the pin 13 that is journaled in the bearing 11 (col. 2, lines 7-12). As the wings 15 spin or rotate, they whip, mix, or stir material that comes in contact with them (col. 2, lines 32-42 & see FIG. 5). Claim 24 depends on Claim 19. Incidentally, Applicants disagree that a potato masher (particularly one with rotating wings) would be useful for pushing leaves into a trash container (see page 2, #2 of the Office action).

The words “stationary” and “permanently adhered” have been inserted into Claim 13(b) and (c), respectively, for clarity. The words “permanently adhered” have been inserted into Claim 19(c) for clarity. Antecedent basis is found in Paragraphs [0041] and [0042] on page 13 of the specification, for example, and in the figures, particularly FIGS. 12 and 13.

b. Hayward

The 1929 Hayward patent also describes a vegetable masher with a mashing and whipping head (line 93). Item 4 designates paddle members 4, not a stationary brace per Applicant’s Claims 13(b) and 19(b). According to Hayward, the masher includes a rim portion 1 connected to a hub 2 by a plurality of alternating spokes 3 and paddle members 4. The vegetables are mashed or beaten to pass between the spokes 3 (lines 42-47). The Claim 13 limitation that the brace is connected on one side to a substantially planar underside of the head portion and the mount portion is adhered to an *opposite* side of the brace is not taught or suggested in this reference.

Claims 14 and 15 depend on Claim 13. Claim 24 depends on Claim 19.

c. Roi

Applicants also respectfully disagree that the third cited reference, Roi, which describes a rotatable vegetable masher, is anticipatory. First, item 1 does not appear to indicate a substantially planar head portion per Applicants’ Claim 16(a). According to Roi, item 1 indicates a handle shaft, which is not the same as a substantially planar head portion.

Secondly, Applicants are unclear as to what “portion above the handle shaft 1” in FIG. 3 is supposedly a mount portion per Applicants’ Claim 16(c). It does not appear to Applicants that any “portion above the handle shaft 1” is the equivalent of a mounting portion. Neither is a mounting portion open end disclosed in Roi. This Claim 16(c) element does not seem to be disclosed in Roi.

Thirdly, item G does not appear to indicate a brace comprising a base attached to a head portion. Roi's item G is a grate, not a brace. His grate G is not attached on one side to a substantially planar underside of the head portion, per Applicants' Claim 16(b).

In Applicants' debris packer, the mount portion is connected to the brace, which is connected to the head portion. This is not the case with the Roi vegetable mashing apparatus, which does not disclose the structural limits as claimed. In Roi's apparatus, the grate G reportedly forms the bottom wall. Means mounted on the side wall press the vegetable against the grate G, which mashes it (col. 4, lines 14-17).

Lastly, the movable parts, swinging crank handle, and the outer container would make this rotatable vegetable apparatus incapable of being used to push leaves or other debris into a trash container (see page 5, #5 of the Office action).

Where a claim is rejected as anticipated by a cited reference, no question of obviousness must be present. "In other words, for anticipation under 35 USC 102, the reference must teach every aspect of the claimed invention, either expressly or impliedly. Any feature not directly taught must be inherently present." See MPEP §706.02(a).

Since Applicants' invention has not been patented or described in the Scheidecker, Hayward, or Roi patents, Applicants' invention is not anticipated by any of them under Section 102(b). Allowance of claims 13-17, 19, 23, and 24 is therefore requested.

3. Rejection under §103(a)

Claim 18 stands rejected under 35 USC §103(a) as being unpatentable over Roi in view of Scheidecker. Applicants disagree. Claim 18 depends on Claim 16, which is believed to be in condition for allowance, as described above.

In Applicants' leaf and debris packer, the open-ended mount portion is connected to the brace, which is connected to the substantially planar head portion. This is not the case with the Roi vegetable mashing apparatus.

According to the Office action, Roi discloses a head portion I, a brace G connected to the head portion I, and a mount portion above the handle shaft I connected to an opposite side of the brace. As discussed above, Applicants' claimed structural limitations, substantially planar head portion, brace connected to an underside of the head portion, and open-ended, generally cylindrically-shaped mount portion connected to an opposite side of the brace, are not taught or suggested by Roi. The elements are not fairly found nor taught in the prior art.

Regarding the comment at the top of page 6 of the office action, Applicants do disclose an advantage of the rectangular shape of the packer apparatus in Paragraph [0040] on page 12: it is especially well-suited to the shape of many trash containers and paper leaf and debris bags.

According to MPEP 2143.01, the prior art must suggest the desirability of the combination of references. Here, the prior art does not suggest the desirability of the claimed combination for packing leaves or other debris into a trash container.

There is no suggestion or motivation to make the proposed modification, and the proposed modification would render the prior art invention being modified unsuitable for its intended purpose. MPEP 2143.01. Specifically, if the grid member 12 of Scheidecker had been substituted for Roi's handle shaft I within his container, the modified apparatus would not mash potatoes. If that substitution would have been made, turning Roi's crank handle M would no longer result in rotation of the grate G, which is at the bottom of the container. In short, the prior art device would not be operable for its intended purpose. Also, in Applicants' leaf packer, the head portion contacts and is used to push the leaves/debris. If the Scheidecker grid member 12 was in the middle of the container, it would not be useful for pushing vegetables or leaves.

The cited art is nonanalogous and would not have presented itself to an inventor's attention in considering his problem (see MPEP 2141.01a). The references were not reasonably pertinent to the problem with which the inventors were concerned because a person having ordinary skill in the art would not have expected to solve the problem of

packing outdoor fallen leaves into a trash container by considering references dealing with potato/ vegetable mashers. Classification also provides some evidence of nonanalogy: Scheidecker and Roi are in Class 146. It is submitted that these references are not within the field of Applicants' endeavor, and are not reasonably pertinent to the particular problem with which the inventors were concerned (see MPEP 2141.01a).

This is the only rejection of Claim 18, which has not been rejected under §102(b). In light of the above, allowance of Claim 18 is requested.

Although Applicants respectfully disagree with these rejections, Applicants seek to gain an auspicious allowance and have therefore voluntarily amended the claims. No new matter has been added by these amendments. Applicants would be pleased to supply additional information in support of this application, or to discuss over the telephone any additional amendments the Examiner considers necessary to place the application in condition for allowance. Applicants request that these amendments be made of record in the case and considered by the United States Patent and Trademark Office Examiner, and that the claims as amended be allowed.

Respectfully submitted,

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